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Ralph E. Jocke
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November 5, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: Application Serial No.: 09/086,857
Confirmation No.: 8855
Appellants: David T. Frederick, et al.
Title: System For Tracking And Dispensing
Medical Items From Environmentally
Controlled Storage Area
Docket No.: D-1093

Sir:

Please find enclosed a Reply Brief in Response to the Examiner's Answer dated September 10, 2004 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 10-0637.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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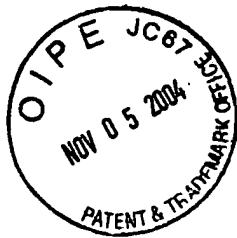
330 • 225 • 1669
CLEVELAND

Ralph E. Jocke
330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

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IFW



D-1093

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: **David T. Frederick, et al.**)
Application Serial No.: **09/086,857**) Art Unit 3653
Confirmation No.: **8855**)
Filed: **May 29, 1998**) Patent Examiner:
Title: **System For Tracking And Dispensing**) Michael E. Butler
 Medical Items From Environmentally)
 Controlled Storage Area)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning the above-referenced Application. The Reply Brief is in response to the Examiner's Answer ("Answer") dated September 10, 2004.

Initial Comments

Extraneous Comments in the Answer

The Answer in the body of certain rejections refers to claims which are not part of the rejection. That is, the Answer contains extraneous comments that should be disregarded. The Office was made aware of extraneous comments in the 2nd Supplemental Appeal Brief ("Appeal Brief") filed May 27, 2004. The following are some examples of extraneous comments in the Answer:

In numbered paragraph 4 (on page 9), reference to claims 42 and 43.

In numbered paragraph 17 (on page 19), reference to claim 35.

In numbered paragraph 18 (on page 20), reference to claim 40.

In numbered paragraph 20 (on page 21), reference to claims 34 and 35.

In numbered paragraph 21 (on page 22), reference to claims 34 and 35.

In numbered paragraph 24 (on page 25), reference to claims 34 and 35.

In numbered paragraph 25 (on page 26), reference to claim 34.

In numbered paragraph 26 (on page 27), reference to claims 11 and 21.

Also, the rejection set forth in numbered paragraph 25 (on page 26) is the same as in numbered paragraph 17 (on page 19). Therefore, duplicative numbered paragraph 25 should be disregarded.

Conflicting Rejections in the Answer

Common claims rejected under 102 and 103 based on Lavigne

Claims 1, 3, 9, 24-25, and 44 are alleged to be anticipated by Lavigne (Issue 2).

Claims 1, 3, and 24-25 are alleged to be obvious over Lavigne (Issue 7).

Claims 1, 3, and 24-25 are alleged to be obvious over Lavigne in view of Aten (Issue 10).

Claims 9 and 44 are alleged to be obvious over Lavigne in view of Holmes (Issue 18).

Claim 9 is alleged to be obvious over Lavigne in view of Iwamoto (Issue 22).

The Examiner has not explained how an anticipating Lavigne differs from the Lavigne needing obviousness to reject the same subject matter of claims 1, 3, 9, 24-25, and 44, or how and why Lavigne is applied in combination with a secondary reference to reject these claims. The Answer is silent as to what Lavigne lacks with regard to the 35 U.S.C. § 103 rejection of claims 1, 3, 9, 24-25, and 44. The Office has not properly conducted a *Graham v. John Deere Co.* analysis in the consideration and determination of obviousness, especially with regard to the differences between the applied prior art and the recited claims. Appellants respectfully submit that it is not legally proper (which is the present situation) to reject the same claims pursuant to both 35 U.S.C. § 102 and 35 U.S.C. § 103 based on the same primary reference.

The Answer has maintained the 35 U.S.C. § 102 rejections based on Lavigne. By definition, the 35 U.S.C. § 103 rejections of claims 1, 3, 9, 24-25, and 44 involving Lavigne are without merit. Thus, the 35 U.S.C. § 103 rejections of claims 1, 3, 9, 24-25, and 44 involving Lavigne must be disregarded. Any arguments made by Appellants' (to avoid a Notice of defective Brief from this Examiner) in the Appeal Brief concerning the 35 U.S.C. § 103

rejections of these claims based on Lavigne in no way waive their rights to have these rejections stricken for the reasons presented.

Common claims rejected under 102 and 103 based on Colson '450

Claims 1, 4, and 24 are alleged to be anticipated by Colson '450 (Issue 3).

Claims 1 and 24 are alleged as obvious over Colson '450 in view of Lavigne (Issue 11).

Claim 4 is alleged to be obvious over Colson '450 in view of Iwamoto (Issue 15).

Appellants' previous remarks involving the legality of the Answer to improperly reject the same claims under both 35 U.S.C. § 102 and 35 U.S.C. § 103 based on the same primary reference are incorporated by reference, and likewise apply. As the Answer has maintained the 35 U.S.C. § 102 rejections based on Colson '450, the 35 U.S.C. § 103 rejections of claims 1, 4, and 24 involving Colson '450 must be disregarded. Any arguments made by Appellants' (to avoid a Notice of defective Brief from this Examiner) in the Appeal Brief concerning the 35 U.S.C. § 103 rejections of these claims based on Colson '450 in no way waive their rights to have these rejections stricken for the reasons presented.

Common claims rejected under 102 and 103 based on Higham

Claim 46 is alleged to be anticipated by Higham (Issue 5).

Claim 46 is also alleged to be obvious over Higham (Issue 8).

Appellants' previous remarks involving the legality of the Answer to improperly reject the same claims under both 35 U.S.C. § 102 and 35 U.S.C. § 103 based on the same primary reference are incorporated by reference, and likewise apply. As the Answer has maintained the

35 U.S.C. § 102 rejection based on Higham, the 35 U.S.C. § 103 rejection of claim 46 involving Higham must be disregarded. Any arguments made by Appellants' (to avoid a Notice of defective Brief from this Examiner) in the Appeal Brief concerning the 35 U.S.C. § 103 rejection of this claim based on Higham in no way waive their rights to have the rejection stricken for the reasons presented.

Common claims rejected under 102 and 103 based on Colson '297

Claim 45 is alleged to be anticipated by Colson '297 (Issue 6).

Claim 45 is also alleged to be obvious over Colson '297 (Issue 9).

Claim 45 is also alleged to be obvious over Colson '297 in view of Lavigne (Issue 13).

Appellants' previous remarks involving the legality of the Answer to improperly reject the same claims under both 35 U.S.C. § 102 and 35 U.S.C. § 103 based on the same primary reference are incorporated by reference, and likewise apply. The Answer has maintained the 35 U.S.C. § 102 rejection based on Colson '297, as evidenced by the Answer at page 35, last paragraph. Thus, the 35 U.S.C. § 103 rejection of claim 45 involving Colson '297 must be disregarded. Any arguments made by Appellants' (to avoid a Notice of defective Brief from this Examiner) in the Appeal Brief concerning the 35 U.S.C. § 103 rejection of this claim based on Colson '297 in no way waive their rights to have the rejection stricken for the reasons presented.

STATUS OF CLAIMS

Claims 1-47 are pending in the Application.

Claims rejected: 1-47

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether Appellants' claims 27-43 are unpatentable under 35 U.S.C. § 112, second paragraph.
- 2). Whether Appellants' claims 1, 3, 9, 24-25, 27, 31-33, 36-38, and 44 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Lavigne.
- 3). Whether Appellants' claims 1, 4, 12-15, 21, 24, 27-29, 31-33, 39, and 44 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '450.
- 4). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Pearson.
- 5). Whether Appellants' claim 46 is unpatentable under 35 U.S.C. § 102(e) as being anticipated by Higham.
- 6). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 102(b) as being anticipated by Colson '297.
- 7). Whether Appellants' claims 1-3 and 24-26 are unpatentable under 35 U.S.C. § 103(a) over Lavigne. However, as discussed above, the rejection is only applicable to claims 2 and 26.
- 8). Whether Appellants' claims 46-47 are unpatentable under 35 U.S.C. § 103(a) over Higham.
- 9). Whether Appellants' claims 45-46 are unpatentable under 35 U.S.C. § 103(a) over Colson '297.

- 10). Whether Appellants' claims 1, 3, and 24-26 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Aten. However, as discussed above, the rejection is only applicable to claim 26.
- 11). Whether Appellants' claims 1-3 and 24-25 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Lavigne.
- 12). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Blechl in view of Weinberger.
- 13). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Colson '297 in view of Lavigne.
- 14). Whether Appellants' claims 16-20 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Engleson.
- 15). Whether Appellants' claims 4-8 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Iwamoto.
- 16). Whether Appellants' claim 23 is unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Warren.
- 17). Whether Appellants' claims 9, 16-17, 20, 22, and 42-44 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Holmes. claims 9, 16-17, 20, and 22
- 18). Whether Appellants' claims 9, 16-17, 20, 22, and 42-44 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Holmes. However, as discussed above, the rejection is only applicable to claims 16-17, 20, 22, and 42-43.
- 19). Whether Appellants' claim 45 is unpatentable under 35 U.S.C. § 103(a) over Halvorson in view of McDonald.

- 20). Whether Appellants' claims 45-47 are unpatentable under 35 U.S.C. § 103(a) over Halvorson in view of Weinberger.
- 21). Whether Appellants' claims 16-20 are unpatentable under 35 U.S.C. § 103(a) over Colson '450 in view of Gombrich.
- 22). Whether Appellants' claims 4-10 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Iwamoto. However, as discussed above, the rejection is only applicable to claims 4-8 and 10.
- 23). Whether Appellants' claims 12-15 and 23 are unpatentable under 35 U.S.C. § 103(a) over Lavigne in view of Genest.

ARGUMENT

Appellants' 2nd Supplemental Appeal Brief filed on May 27, 2004 is incorporated herein by reference. The rejections presented in the Answer are substantially identical to those previously presented in the Office Action dated May 6, 2004. Appellants respectfully submit that these rejections have already been fully addressed in the (2nd Supplemental) Appeal Brief. Please refer to Appellants' previous arguments regarding all the issues of record.

Appellants further explain their arguments that Lavigne in view of Aten do not render claims 45 and 47 obvious. Claim 47 depends from claim 45. The Office has admitted (e.g., in the Advisory Action dated November 7, 2000) that "The affidavit was effective in overcoming the rejections to claim 45 in view of Lavigne & Lavigne/Aten." Furthermore, as previously discussed, Lavigne does not constitute prior art with regard to claim 45.

Additionally, the Answer by inference admits that Lavigne does not anticipate claims 45 and 47. If an independent claim (i.e., claim 45) is nonobvious under 35 U.S.C. § 103, then any claim (i.e., claim 47) depending therefrom is nonobvious (MPEP 2143.03). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The rejection of Lavigne combined with Aten does not specifically cite any features in Aten that are relied upon to reject claims 45 and 47. The only discussion in the Action concerning Aten that mentions any features recited in the rejected claims, is claim 26, which relates to the referred to "permanent magnet." That is, claim 26 is the only claim to which Aten is even relevant. It follows Aten cannot be relied upon to render claims 45 and 47 obvious. It further follows that Lavigne in view of Aten cannot render claims 45 and 47 obvious.

Response to Arguments

The Answer includes a "Response to Argument" section beginning on page 29.

The Answer on pages 29-31 alleges that claim 24 is not entitled to the priority date of its parent (apparently parent patent 5,790,409 filed 12/16/94), and thus the date of the cited art has not been antedated. The Appellants respectfully disagree. Appellants have already addressed this issue in detail in the Appeal Brief (e.g., pages 24-33). The Examiner ignores the similar scope of claims 24 and 45; the entered 37 CFR 1.131 Declaration; and differences that may be obvious to one having ordinary skill in the art.

One skilled in the art of patent prosecution would recognize that claim 24 is similar in scope to claim 45. The Answer acknowledges at page 30, lines 2-4, that claim 45 effectively finds support in the parent patent.

Appellants' 37 CFR 1.131 Declaration submitted on September 27, 2000 was entered and deemed effective by the Office to swear behind a date prior to March 7, 1994 for at least claim 24 and claim 45, as indicated in the Advisory Action dated November 7, 2000 and the Notification dated April 9, 2001.

Appellants' inventive possession also carries with it possession of variations and adaptations which would have been obvious at the same time (MPEP § 715.02). The Office (via the 35 U.S.C. § 103 rejections) considers the claim 24 features to be obvious to one of ordinary skill in the art. That is, the Office itself (via the 35 U.S.C. § 103 rejection of claim 24) indicates that *exterior* mounting of a lock on a housing would have been (at the time of Appellants' invention) obvious to one of ordinary skill in the art. Also note the Answer at page 37, lines 7-9.

The mentioning of "refrigeration elements" (on page 29, line 16) and "refrigeration" (on page 31, line 12) in the Answer with regard to claim 24 is misleading. Claim 24 (nor claim 45) does not recite "refrigeration." For claim 24 (and claim 45) the Declaration can properly swear behind a prior date. Apparently the Examiner confuses claims 24 and 45 with claims 1 and 27, which have the term "refrigerator."

In review, the relied upon references of Engleson, Iwamoto, Holmes, Lavigne, Colson '450, Pearson, and Higham do not constitute prior art against at least claims 24 and 45.

Beginning on page 30, the Answer alleges that the Declaration does not swear behind the priority date of Colson '450. As explained in the Appeal Brief beginning on page 29, the older Colson '297 does not disclose the recited claim features for which the newer Colson '450 was applied. A Declaration need not swear behind the date of a reference (i.e., Colson '297) that does not have the recited features. The Board should suspiciously ask the following question: If the earlier Colson '297 has the recited features (as alleged), then why was the later Colson '450 applied? Appellants respectively submit that the Office did not apply the older Colson '297 because it does not provide support the features relied upon in Colson '450. Even if it were somehow possible for the newer Colson '450 to have had the recited features, it still would not have been entitled to the earlier filing date of Colson '297 for the features, because the features are lacking in Colson '297. The Declaration properly swears behind Colson '450. Colson '450 does not constitute prior art against at least claims 24 and 45.

The Answer on pages 31-32 alleges that the claims depending from independent claims 24 and 45 are not entitled to their earlier effective date of the independent claims (i.e., either the priority date to parent patent 5,790,409 or the swear behind date in the Declaration). The Office has not explained how it can legally reject these dependent claims as obvious on one hand, yet on the other hand deny them entitlement (in spite of their alleged obviousness) to either the priority date to the parent patent 5,790,409 or the swear behind date in the Declaration. Appellants' inventive possession also carries with it possession of any variation that is obvious at the time of possession (MPEP § 715.02).

Appellants also maintain that if an independent claim (e.g., claims 24 and 45) is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is likewise nonobvious (MPEP 2143.03). A dependent claim merely adds a limitation to those limitations already in the independent claim. The added limitation of a dependent claim is only meaningful if it is relied on for patentability. Particularly note *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 n.36, 1 USPQ2d 1593, 1604 n.36 (Fed. Cir. 1987). *In re Fine*, supra.

The Answer on pages 32-33 reiterates the 35 U.S.C. § 112, second paragraph, rejections. Appellants have already addressed this issue in detail in the Appeal Brief (e.g., pages 33-36).

The Answer on page 33 includes the heading "Rejections under 35 USC 103". Apparently the heading should have referred to 35 U.S.C. § 102 because the comments that follow involve "cited anticipatory references." How the comments relate to specific claims and arguments made in the Appeal Brief is unclear as they do not reference corresponding specific

locations in the Appeal Brief. The comments completely ignore Appellants' arguments made in the Appeal Brief. The Examiner's comments are incomprehensible. Appellants refuse to speculate how the comments are applicable (if they even are). The comments also do not explicitly read the claimed invention on the mentioned references. The comments lack evidence and are merely empty allegations.

The Answer on page 34 includes the heading "Rejections under 35 USC 102". Apparently the heading should have referred to 35 U.S.C. § 103 because the comments that follow relate to 35 U.S.C. § 103 type rejections (as best understood). How the comments on pages 34-38 relate to specific claims and arguments made in the Appeal Brief is unclear as they do not reference corresponding specific locations in the Appeal Brief. The comments completely ignore Appellants' arguments made in the Appeal Brief. The comments lack evidence and are merely empty allegations. The Examiner's comments are incomprehensible. Appellants refuse to speculate how the comments are applicable (if they even are).

The Answer on page 36, lines 3-7, refers to Blechl at col. 8, lines 60-68. The Answer asserts (as best understood) that Blechl states that other authorization systems using passwords and personal computers may be used, instead of a card, to verify authorized users. The Appellants respectfully disagree. Blechl does not teach or suggest a computer in operative connection with a data store that holds data for a *plurality* of authorized users (e.g., claim 45). Instead, Blechl has each user insert their card and input data. The inputted data is compared to data stored on the card. If there is a match then access is allowed.

Blechl at col. 8, lines 60-68, does not disclose a computer (especially an alleged personal computer) in operative connection with a data store, especially a data store having user data representative of a plurality of authorized users. Blechl at col. 8, lines 60-68, does not teach against using cards. Blechl does not teach against storing data representative of passwords, fingerprints, voice identification, hand prints, or signs on a card. This is evidenced by Blechl's mentioned use of fingerprints (col. 4, line 34), retina scan (col. 4, line 34), PIN (col. 4, lines 31-33), and passwords (col. 8, line 47) with cards. Nowhere does Blechl teach that he relies on a data store to hold data for a *plurality* of authorized users, where a computer is in operative connection with the data store.

The Answer on page 36, last paragraph, refers to "Lavigne and Genest." The Answer alleges that "The reader 12 is clearly machine readable indicia."

The rejection involving Lavigne and Genest applies to claims 12-15 and 23. However, none of these claims even mention "indicia." Even if they did, it is unclear how a reader device could constitute machine readable indicia. The Examiner's comments are incomprehensible.

The Answer on page 37, lines 14-19, shows apparent confusion on the part of the Examiner. These lines are repeats of lines already presented on page 36, at lines 14-19.

Appellants respectfully disagree with the comment (at Answer page 34, lines 8-10) that if one claim is rejected then all claims should be commonly rejected. Appellants' petition against the Examiner's improper restriction requirement was *granted*. The Examiner's comments

regarding the restriction and "invention groups" are moot. Also, one skilled in the art of patent prosecution understands that a "distinct" relationship with regard to restriction practice is different than "patentably distinct" subject matter with regard to prior art. Claims directed to a single invention can still vary in scope. With the Examiner's reasoning, dependent claims would always stand or fall with their independent claim. Each one of Appellants' pending claims stands on its own merits.

Appellants take exception to the Examiner's derogatory personal remarks on pages 38-39 under the heading "Excessive Brief Size." These remarks merely confirm in writing the undeserved malice demonstrated against Appellants during the entire prosecution history. The non primary Examiner's lone crusade to change the rules to limit Appeal Briefs to only 30 pages has been defeated, as evidenced by the many granted petitions ruling against this Examiner on this same issue. The attempt to impose a 30 page Appeal Brief limitation on Appellants after applying 20+ different art rejections (resulting in 100+ individual claim rejections) was judged to be in clear error by the Examiner's own Group. The vain attempt to limit Appellants' Brief to less than 30 pages when the Examiner's Answer itself is more than 30 pages defies reason, in addition to being contrary to law. There are publically and legally available procedures available for an Examiner to properly propose a patent prosecution rule change. Using Appellants' patent application prosecution as a personal podium (without Appellants' permission) is not one of them. Such arguments and rejections by this Examiner constitute unlawful arbitrary and capricious conduct by the Office in violation of the Administrative Procedures Act.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

Ralph E. Jockey
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000